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3-27-02
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Charles E. Farley et al.

Application No. 09/694,789

Filed: October 24, 2000

For: EMULSIFICATION OF
ALKENYL SUCCINIC
ANHYDRIDE SIZE

Group Art Unit: 1731

Examiner: J. Fortuna

Atty Docket: 005242.87031

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

In response to the Office Action mailed February 25, 2002, Applicants elect with traverse the invention of Group I, i.e., claims 1-8.

The Office Action contends that the inventions of Groups I and II are "unrelated." The Manual of Patent Examining Procedure (M.P.E.P.) provides guidance on what is meant by inventions being "unrelated" (independent).

Two different combinations, not disclosed as being capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

M.P.E.P. § 806.04 (emphasis added). The examples presented in the M.P.E.P. illustrate that "unrelated" inventions not only have different modes of operation, function, or effect, but also are not capable of use together. Indeed, the M.P.E.P. recognizes that an application claiming unrelated or independent inventions "is but rarely presented, since persons will seldom file an application containing disclosures of independent things." M.P.E.P. § 808.01.

In the subject application, the emulsified size (claim 8, Group I) can be used to prepare paperboard or paper (claims 9 and 10, respectively, Group II). It is respectfully submitted that the inventions are not "unrelated" (or "independent") within the meaning of M.P.E.P. § 806.04.

Moreover, because Group II claims depend on Group I claims, it is respectfully submitted that search and examination of Group II claims together with Group I claims would not present an undue burden.

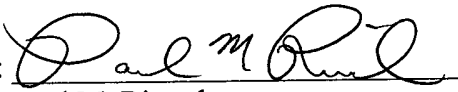
Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: March 20, 2002

1001 G Street N.W.
11th Floor
Washington, D.C. 20001
(202) 508-9100

By: 
Paul M. Rivard
Registration No. 43,446